

At the interview, Tracy explained that she had submitted a disclosure document to the PTO and hired Mr. Van Epps as her patent counsel. For reasons that are not understood, he prepared and filed a design patent application on behalf of applicant. In due course, Applicant Tracy had to terminate Mr. Van Epps and take up some of the prosecution herself. She then hired other counsel to file a utility patent application. Her disclosure document is of record at the PTO, and on belief, it has been reviewed by the Examiner. There can hardly be a question that Mrs. Tracy was in possession of her invention as of the date(s) on the invention disclosure document.

The major question now at issue is whether Applicant will be accorded the benefit of the filing date of her 1987 design patent application for the pending claims of the present application. Applicant herewith tenders argument thereon, a second declaration of the inventor Tracy, and a minor amendment to correct a typographic error in one claim.

#### The Pending Claims

The claims currently pending include independent claim 7, independent claim 8, and dependent claims 9-10.

Independent claim 7 was added in the preliminary amendment dated June 29, 1998. One of its punctuation marks was changed in Amendment B dated January 29, 1999. Among other things, claim 7 specifies that the disposable diaper includes a soft padding member located along at least one of the waistband portions, adjacent to a plastic layer edge, with a soft padding member so that the diaper presents a soft surface at the inside of the diaper waistband portion despite the plastic layer edge.

Independent claim 8 does not use the word "soft." Specifying a disposable diaper having a body portion with enlarged end portions and a narrowed intermediate portion, a waistband portion, a layer of liquid absorbent material, and a plastic layer having an edge at the edge of the diaper. Claim 8 recites a strip of non-abrasive material along at least one of the waistband portions. Further, the disposable diaper of claim 8 requires the strip to be substantially adjacent to the plastic layer edge. The strip is distinct from the body portion layer, and provides a cushion between the diaper wearer and the plastic layer edge so that the diaper presents a cushioned surface at the inside of the

diaper waistband portion despite the plastic layer edge.

Dependent claims 9 and 10 specify that the strip or the soft padding member, as the case may be, extends from the inside to the outside of the diaper, wrapping over the plastic layer edge. Claim 10 is based on independent claim 7, and claim 9 should be based on claim 8. A typographic error has been noticed, and claim 9 is proposed to be corrected so that it will depend from claim 8 rather than from claim 7. Indeed, claim 9 cannot depend from claim 7 because claim 9 recites a "strip" which wraps from inside to outside, over the plastic layer edge, and claim 7 does not recite any "strip." The error is regretted, but it is respectfully submitted that it is proper to correct the claim dependency herein since the error was just discovered and it does not appear that any rejection of claim 9 was based upon any misreading of the claim, nor that any new search would be required, particularly since claim 10 claims the same dependent feature and has already been searched.

#### The Effective Filing Date

On the issue of the filing date to which these claims are entitled, applicant respectfully submits that the date of filing the design patent application should be accorded to this subject matter. That date is September 8, 1987 for Serial No. 093,681. The title of that application was "Ornamental Design for a Disposable Diaper." That 1987 application showed the same subject matter of Figs. 1, 2, and 3 of the present application, but it did not include the written description thereof nor did it include the reference numerals that were introduced in the utility application filed on April 30, 1990.

#### 1. Applicable Caselaw

The Federal Circuit has considered priority claims from a utility patent to a previously filed design patent application. In Vas-Cath v. Mahurkar, 19 USPQ2d 1111 (Fed. Cir. 1991), reversing the district court below, the court mentioned the following:

- The prior application does not have to describe exactly the subject matter claimed. The description must clearly allow persons of ordinary skill in the art to recognize that the applicant invented what is claimed. 19 USPQ2d at 1116, citing In re Gosteli, 872 F2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).
- The test for sufficiency of support in a parent application is whether its disclosure reasonably conveys to the artisan that the inventor had possession at that time of the later claimed

subject matter. *Id.* citing Ralston Purina v. Far-Mar-Co., 772 F2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985).

- There is no statutory prohibition against an applicant relying on the disclosure of a design application, if the statutory conditions are met. *Id.* at 1117. The practical, legitimate inquiry in each case is what the drawing discloses to one skilled in the art. It appears to be inconsequential whether the support comes from specification or drawings. *Id.* at 1118, citing In re Wolfensperger, 302 F2d. 950, 133, USPQ 537 (CCPA 1962).
- Consideration of what the drawings conveyed to persons of ordinary skill is essential. *Id.* at 1119.

## 2. Application to Claims 9-10

Applying these legal standards to the claims under rejection, in this case it is easiest to take the claims in reverse order. That is, the subject matter added by the two dependent claims can easily be resolved. The figures of the 1987 design application clearly show a strip has been added around most of the periphery of the diaper -- at both the narrowed intermediate (crotch) portion of the diaper and on both waistbands. Fig. 1 shows clearly that this added strip is on the diaper exterior, where it extends from the inside to the outside of the diaper, along the waistband and the leg holes. The sectional drawing shows how the strip wraps over the ends. Accordingly, the subject matter of claims 9 and 10 (the strip or soft padding member extends from inside to outside the diaper, wrapping over the plastic edge) is clearly disclosed in the 1987 design patent application.

## 3. Application to Claim 8

Independent claim 8 also is clearly entitled to the 1987 filing date. The issue raised by the examiner in the rejection of claim 7 concerns the word "soft," but that word does not appear in claim 8.<sup>1</sup>

Inspection of the 1987 design application drawings shows readily that there is a strip of material located in the portions recited and claimed in pending claim 8. With regard to the limitation that the strip is "non-abrasive," it is respectfully noted that the Examiner himself has held that the "non-abrasive" feature was either inherent or would have been obvious. Final Rejection at page 5.

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<sup>1</sup>In the final rejection mailed January 19,2000, at paragraph number 14, the Examiner stated that Foreman is a 102(b) reference because the design application [of applicant] does not provide support for the material along the edge of the waistband being a soft padding member.

It is also evident that the 1987 design patent application clearly contemplated a plastic layer having a plastic layer edge. The title given to the design patent application referred to a disposable diaper. Disposable diapers from before that time frame, through today, include a plastic layer outward from the liquid absorbent substance. The plastic layer is to be liquid impervious, and acts as an outer containment layer. The design drawings show such an outer layer. By September 8, 1987 (the filing date), one of ordinary skill in the art would have understood that in a disposable diaper (according to the title of the application), that contemplated a plastic outer layer. Moreover, the specification of Tracy in U.S. Patent 5,797,824, using the same drawings but with a written description added, indicates that the disposable diaper includes "an outer liquid impervious outer sheet 16a and an inner liquid permeable sheet 16b as is well known." Col. 2, lns. 8-10. Hence, the same outer layer of the design patent is the plastic layer of the illustrated embodiment of the present application.

Next, the edge of the plastic sheet 16a is seen in the sectional drawing filed in 1987 as part of the design application. The sectional view as described in the design application is taken along the section line 3-3 of Fig. 2. There is no reason why the ordinarily skilled artisan would conclude that the plastic layer would go to the edge of the diaper along the leg holes and not do the same in the waistband area. Accordingly, it cannot be seriously challenged that as of her 1987 filing date, applicant Tracy was in possession of this feature (the plastic layer has an edge at the diaper edge by the waistband) of the subject matter now specified in claim 8.

Likewise, it is undeniable that the strip of material shown in the 1987 design patent drawings is "distinct from all of said body-portion layer." It is clearly seen as a separate element of the diaper, rather than a mere extension of any body portion.

Finally, it is respectfully submitted that the design drawings do show that this strip of claim 8 provides a cushion. It is clearly seen to be located between what must be a plastic layer edge and the body of the wearer, and it provides added cushioning. See the Second Tracy Declaration, attached hereto.

Accordingly, Applicant Tracy respectfully submits that all of the subject matter of pending independent claim 8 is entitled to the September 8, 1987 filing date of Serial No. 093,681 for her design patent application.

4. Application to Claim 7

Independent claim 7 is similar to claim 8 but does not specify a strip. Rather, it claims the aspect of the outer strip 50 of the preferred embodiment to the extent that it is "a soft padding member." Claim 7 further specifies that the soft padding member includes a material formed from a soft substance...so that the diaper presents a soft surface at the inside of the diaper waistband portion despite the plastic layer edge. The plastic layer edge has already been discussed above with regard to claim 8. Hence, the main issue -- if not the only issue -- with claim 7 that differs from claim 8 concerns the limitations in claim 7 regarding softness.

The Examiner is again reminded that at page 5 of the Final Rejection, he held that a fabric outer strip 22 in McConnell inherently is soft and non-abrasive, or [alternatively] would have been obvious to one of ordinary skill in the art "because it is well recognized that babies' skin is soft and easily irritated..." One of ordinary skill would not cover an elastic band with a hard or abrasive material, as that would defeat the purpose of covering it. While Applicant does not concede that McConnell discloses or suggests the present invention, Applicant asserts that the disclosure of the material in her 1987 design application drawings are fairly interpreted as soft padding members. Applicant tenders herewith the declaration of Rhonda Tracy on this subject. The Examiner should concede, we submit, that it would be very strange indeed if the member shown at the waistband and leg holes of the design patent application were hard or abrasive. If they were, they simply would not be suitable for use in the location of a disposable diaper to be used on the tender skin of a baby.

Thus, Applicant submits that the subject matter of claim 7 is entitled to December 8, 1987 as its effective filing date.

Foreman Is Not Available As a Reference

On the basis that claims 7-10 are entitled to a September 1987 effective filing date, Applicant respectfully submits that the rejection of claims 7-10 over Foreman alone or in combination with

other references can be (and has been) overcome. Foreman issued as a patent on March 28, 1989, which is many months junior to the filing date of the Tracy design patent application in 1987. Hence, since Foreman is not a Section 102(b) reference against these claims, it can be sworn behind, and Applicant has already submitted papers doing just that. *See* the Declaration of Rhonda Tracy dated January 28, 1999 attesting, among other things, "I conceived my invention prior to October 10, 1986\*\*\*. I created a model of my invention before my first meeting with my first patent attorney, Roger Van Epps, and I left my prototype with him at the first meeting\*\*\*. I created my prototype prior to October 3, 1986."

For the reasons discussed above, Applicant respectfully requests withdrawal of the rejection that claims 7 and 8 are fully met by Foreman U.S. Patent 4, 816,025, as indicated in paragraphs 3-4 of the Final Rejection. Moreover, Applicant respectfully requests withdrawal of the rejection using Foreman in combination with Lindquist as stated in paragraphs 6-7 of the final rejection. It is noted that in paragraph 7, only claim 7 was rejected over this combination. For the reasons discussed, Foreman is not available as a reference to be used in such a hypothetical combination.<sup>2</sup>

#### Remaining Rejections Overcome

Three issues remain: the Section 112 rejection of claim 7 for the word "soft"; the art rejection of claim 7-10 over McConnell et al. 3,461,872; and double patenting. Again, it is convenient to take these up in reverse order.

#### Terminal Disclaimer

Tracy previously submitted a terminal disclaimer in this case. However, it is understood from the interview that the reason for the continued double patenting rejection is that the terminal disclaimer submitted by Applicant failed to allege (explicitly) that Applicant owns 100% of the application. Applicant argued that it was evident from the papers filed that she was indeed the sole

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<sup>2</sup>Applicant does not waive her arguments that are of record to distinguish her invention from Foreman and the postulated combination(s) using Foreman.

owner. The Examiner has indicated that Tracy can file a supplemental terminal disclaimer stating that she has 100% of the whole interest. Such a supplemental terminal disclaimer is enclosed herewith, containing such a recitation. This form was downloaded from the PTO web site.

McConnell

McConnell et al. 3,461,872 is for a "diaper retaining garment." Like the rubber pants of yesteryear, this clearly is not a diaper itself, as seen from the opening paragraphs of this citation:

"In the past, many garment constructions have been devised for the purpose of retaining and supporting a diaper in position on a wearer.\*\*\* In practice, the diaper supporting and retaining garment is reused many times while the disposable diaper pads are discarded after becoming soiled in use.\*\*\* Therefore, it is an object of the present invention to provide a new and improved diaper retaining garment."

Cols. 1-2, *passim*. Simply put, McConnell does not disclose or suggest adding soft padding or cushioning to a disposable diaper. It discloses the addition of a fabric outer strip 22 to prevent contact of the wearer with the elastic material which form strip 21 of a separate "garment" that holds a diaper in place. McConnell is intended to be used with a disposable diaper that fits inside of the retaining garment, as contemplated in Figs. 5 and 6. Thus, Fig. 5 shows the disposable pad which is separate from the outer retainer shown in Fig. 1. The combination of the two is seen in Fig. 6.

McConnell teaches that the covering 22 extends over an elasticized material. The construction of the diaper using an elastic material 21, which wraps from inside to outside of the retaining garment, as shown in Fig. 2, is described in Col. 3 at lines 5-30. The elastic material 21 is added as a further member to give the garment shape. Then, to prevent contact of the elastic material 21 with the skin of the wearer, McConnell et al. adds "fabric outer strip 22." There is no teaching here that the fabric outer strip 22 is to prevent contact of the wearer with the plastic edge. Instead, it is for the purpose of avoiding contact with elastic material.

The Examiner will appreciate that independent claims 7 and 8 talk about using the soft

padding member or the strip for diverting the effect of a plastic layer edge. This is a different problem than dealing with elastic material.

In addition, there is no suggestion in McConnell et al. of integrating the strip 22 of McConnell, even if it were deemed to be padding or a cushion, onto a unified disposable diaper. Instead, this is for a separate diaper retaining garment. The Tracy claims, on the other hand, call for a disposable diaper rather than a diaper retaining garment.

“Soft” Is Not Indefinite

The final basis for rejection is the use of the word “soft” in claim 7. This rejection is stating in paragraph number 1-2 of the final rejection. Applicant respectfully submits that the PTO Board of Appeals has already accepted this word. In any event, the Examiner himself uses it in the rejection by specifying that the material of McConnell is inherently soft. The reasons stated by the Examiner is that the material is to be in contact with the skin of a baby, and one would understand that the material should be soft. The use of the word “soft” in claim 7 does not make claim 7 indefinite. One can determine whether a material is soft by touching it, that is, by tactile sensation. Hence, the word soft is readily understood by persons of ordinary skill in the art in the context of a disposable diaper, particularly one which will be used by babies, the most common wearers of such apparatus. *See* the accompanying Declaration of Rhonda Tracy, ¶7.

Conclusion

For the foregoing reasons, the rejection of all claims is respectfully traversed and favorable action is earnestly solicited. This amendment after final should be entered because it seeks to overcome all the issues in the case, addresses concerns discussed at the recent interview with the Examiner, does not increase the number of claims, reduces the number of issues for appeal if such be necessary, and was not presented earlier because the issues to be addressed were still being refined. Moreover, no substantive amendment is offered herein, so no new search would be required.

No fee is thought to be occasioned by the present amendment, since it is tendered within three months of the final rejection mailing date of January 19, 2000 and no claims are added. The fee for the terminal disclaimer was paid previously so no fee should be due for the supplemental terminal disclaimer. However, should any fee be required, you are authorized to charge it to the account of Cook, Alex, McFarron, Manzo, Cummings & Mehler, 50-1039.

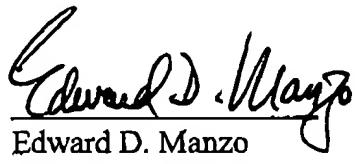
Respectfully submitted,

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Dated: April 19, 2000



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Enclosures: Second Declaration of Rhonda Tracy  
Terminal Disclaimer